

REMARKS

By the *Office Action* of 24 March 2005, Claims 1-43 are pending in the Application, with Claims 1-43 being rejected. By the present *Response and Amendment*, Applicant amends Claims 1-5, and 7-43, cancels Claim 6, and adds Claims 44-50. After entry of this *Response and Amendment*, Claims 1-5 and 7-50 will be pending.

Applicants file the present *Response and Amendment* in an effort to move the case to issuance. No new matter is believed introduced by the present *Response and Amendment*. It is respectfully submitted that the present Application is in condition for allowance for the following reasons.

1. Docket Number and Change in Correspondence Address

Applicants respectfully request the docket number of this Application be changed from 58683-00002USPX to DSP1. The prosecution of this Application has been transferred to a new law firm (Troutman Sanders LLP), and its docketing procedures will utilize this new docket number. A *Revocation and Appointment of Power of Attorney* to the new firm, and a *Change of Correspondence Address* will soon be filed to reflect that the new law firm is now prosecuting this Application.

2. The Pending Claims

In light of the amendments to the pending claims, Applicant respectfully asserts that pending claims are in condition for allowance over the cited references. Applicant amends the pending claims to clarify Applicant's claimed invention, and Applicant believes that the clarified amended claims will not necessitate another search. The pending claims, as amended, are patentable over the cited references because the cited references do not individually or collectively teach or suggest all of the elements, features, and limitations contained in the claims.

Specifically, the cited references do not teach or suggest "applying a predictable noise to each signal path to generate an output noise" as recited in Claims 1 and 42; "a module for applying a predictable noise to each signal path to generate an output noise" as recited in Claim 16; and "a circuit for applying a predictable noise to each signal path to generate an output noise" as recited in Claim 43. Accordingly, Applicants respectfully assert that these claims are allowable over the cited references, and that the dependent claims are also allowable for the

further limitations contained therein. The *Specification* provides support for these features of Applicant's claimed invention on Page 13, Lines 3–16.

3. 35 U.S.C. § 112 Claim Rejections

In the *Office Action*, the Examiner rejects Claims 1, 16, 42, and 43 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner specifically asserts that these “claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.”

Applicant apologizes that previous counsel did not clearly show the antecedent basis for the previous changes to the claims that precipitated this ground of rejection. Applicant respectfully asserts that Claims 1, 16, 42, and 43 are enabled by the originally filed specification. Specifically, these claims are enabled by at least the material provided within Page 10, line 28 – Page 15, line 18 of the original filed *Specification* (Paragraphs 49-62 of the published version of the application) and FIGS. 2A-B and 3. Accordingly, Applicant respectfully requests the § 112, first paragraph rejections to Claims 1, 16, 42, and 43 be withdrawn.

4. 35 U.S.C. § 102(b) Claim Rejections

Claims 1-6, 10, 16-21, 28 and 33-43 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gardner (U.S. Patent No. 5,737,433). In light of the above presented clarifying claim amendments, Applicant respectfully traverses the §102(b) claim rejections.

Applicant respectfully submits that Gardner does not teach or disclose “applying a predictable noise to each signal path to generate an output noise” as recited in Claims 1 and 42; “a module for applying a predictable noise to each signal path to generate an output noise” as recited in Claim 16; and “a circuit for applying a predictable noise to each signal path to generate an output noise” as recited in Claim 43. Accordingly, Applicant submits that independent Claims 1, 16, 42, and 43 are allowable over Gardner. In addition, Applicant respectfully submits that dependent claims 2-5, 10, 15-21, 28, 33-41 are also allowable over Gardner for the further limitations contained therein.

Gardner teaches a sound environment control apparatus. The primary purpose of Gardner's apparatus is to allow a user to selectively control sound in an environment by

suppressing unwanted sounds and providing desired sounds to a headset worn by a user. (Gardner, Column 2, Lines 7-22). In utilizing Gardner's apparatus, a user places primary sound detectors and reference sound detectors in an environment. (Gardner, Column 2, Lines 22-67). The primary sound detectors are used to pick up desired sounds and the reference sound detectors are used to pick up unwanted sounds. (Id.) The sound detectors provide the sound signals to a processing unit and in response to user selected controls, the processing unit provides desired sounds to a user, while suppressing the unwanted sounds. (Id.)

Gardner, however, does not teach or disclose utilizing a predictable noise to each signal path to generate an output noise as claimed by Applicant. Indeed, Gardner's teaching to utilize sound detectors to pick up various erratic, irregular, and unpredictable sounds teaches away from Applicant's claimed invention. For example, Gardner discloses examples of unwanted sounds: "noisy machinery, power tools, dental drill noise, another person's voice (e.g., for person-to-person communication, propeller noise from helicopters and aircraft, engine noise, televisions, stereos, noisy children, crying babies, barking dogs, window-mounted air conditioners, street noise entering a room through a window, and the like." (Id.) In addition, Gardner's discussion of desired sounds also includes non-predictable noises. Thus, the sounds picked up by Gardner's sound detectors are not predictable noises and Gardner does not utilize or teach utilizing predictable noises; thus Applicant's claimed invention is allowable over Gardner. Withdrawal of the § 102(b) claim rejections is, therefore, respectfully requested.

5. 35 U.S.C. § 103(a) Claims Rejections

Claims 7-13, 15, 22-27, 28-29, and 31-38 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of base reference Gardner and various other secondary references. As discussed above, Applicant respectfully believes that Claims 1-5 and 7-43 as amended are patentable over Gardner. For these same reasons, Applicant respectfully submits that Claims 7-13, 15, 22-27, 28-29, and 31-38 are patentable over the various combinations used to reject these claims. In other words, Applicant respectfully asserts that the various combinations do not teach or suggest "applying a predictable noise to each signal path to generate an output noise" as recited in Claims 1 and 42; "a module for applying a predictable noise to each signal path to generate an output noise" as recited in Claim 16; and "a circuit for applying a predictable noise to each signal path to generate an output noise" as recited in Claim 43.

Accordingly, Applicant respectfully asserts that Claims 7-13, 15, 22-27, 28-29, and 31-38 are in allowable form. Withdrawal of the §103(a) rejections to these claims is respectfully requested.

6. New Claims 44-50

Applicant adds new Claims 44-50 to further clarify Applicant's claimed invention. Applicant respectfully asserts that Claims 44-50 are allowable over the cited references for the reasons discussed above as they are dependent upon allowable base claims. It is believed that new Claims 44-50 do not introduce any new matter into the Application as these new claims are supported by the *Specification* at Page 5, Lines 13-14; Page 11, Line 15-Page 12, Line 6; and Page 12, Line 19-Page 15, Line 12.

7. Entity Status Change Pursuant to 37 C.F.R. § 1.27

Pursuant to 37 C.F.R. § 1.27(g)(2) Applicant requests that the Small Entity status for this Application be withdrawn due to a change in entity status in November 2004. In conformance with this entity change, Applicants submit herewith an additional fee payment for fees recently paid at the small entity rate, which should have been paid at the non-small entity rate. This additional fee payment reflects the differential amount between the small entity rate and the non-small entity rate. Specifically, Applicants submit herewith an additional \$395.00 for the 24 January 2005 RCE filing. With payment of this additional fee, Applicants have now paid the appropriate non-small entity fees for the 24 January 2005 RCE filing. Additionally, Applicants submit herewith the appropriate, non-small entity extension and claims fees as discussed below.

8. Fees

This *Response and Amendment* is being filed within five months of the *Office Action*, thus Applicant submits herewith a petition for a two-month extension and the applicable non-small entity fee (\$450.00).

The number of Claims has changed due to the above-presented amendments. Specifically, Applicant cancels one dependent claim and adds seven dependent claims. Thus overall, Applicant adds six new dependent claims. Accordingly, Applicant submits herewith the applicable non-small entity fee for the additional six claims over twenty (\$300.00).

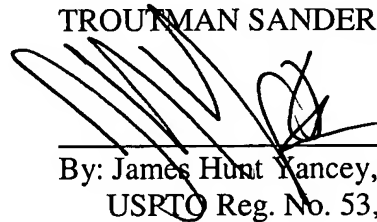
Applicants believe that no additional fees are due, however, the Commissioner is authorized to charge any other fees or credit any overpayments to Deposit Account No. 20-1507.

CONCLUSION

By the present *Response and Amendment*, the Application is believed to be in form for allowance. If the Examiner has any further questions or reservations, or believes that an Examiner's amendment will place the Application into condition for allowance, the Examiner is invited to telephone the undersigned Attorney at 404.885.3696.

Respectfully submitted,

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